



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------------|---------------------|------------------|
| 09/929,376 | 08/14/2001 | Pedro Luiz Discacciati Fortes | D/A0620 | 1002 |

7590 06/20/2007
Mark S. Svat, Esq.
Fay, Sharpe, Fagan, Minnich & McKee, LLP
7th Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

| |
|----------|
| EXAMINER |
|----------|

GRAHAM, CLEMENT B

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3692

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/929,376

Applicant(s)

FORTES ET AL.

Examiner

Clement B. Graham

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 remained pending.

Claim Rejections - 35 USC § 112

- 2 The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 1, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, Claim 1, recites the words ["commodity parts or devices"]. However this language fails to distinctly claim Applicant's invention because the scope of the claim is unclear, as to what is the difference between commodity parts or devices, Moreover the specification fails to clarify, the meaning of the limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
5. Claims 1-9, are rejected under 35 U.S.C. 102(b) as being anticipated by Giovannoli U.S Patent 5, 842, 178).

As per claim 1, Giovannoli discloses a method of exchanging data between a buyer and a plurality of multiple suppliers via an internet supplier on-line system: generating by a buyer a request for a quotation from at least some of the plurality of suppliers for a cost of a part or device(Note abstract and see column 1-8 lines 1-67) determining if the request for the quotation will include attachments; generating documents when the request for quotation will include attachments, wherein the request for quotation and attachments include both engineering and business

Art Unit: 3692

documents determining which of the plurality of suppliers are to be provided with the request for quotation and attachments(Note abstract and see column 1-8 lines 1-67) inquiring whether all suppliers to be provided with the request for quotation and attachments are registered on the supplier on line system; registering the suppliers not on the supplier on-line system; notifying the buyer, automatically by the supplier on-line system, of the registration of the suppliers(Note abstract and see column 1-8 lines 1-67) determining whether the request for quotation is for a commodity part or device or is for a non-commodity part or device and selecting which of the generated documents are to be attached as part of an item bidding process corresponding to each of the commodity parts or devices or selecting which of the generated documents are to be attached as part of a service bidding process corresponding to each of the non commodity parts or devices, building the request for quotation, wherein the building includes joining the business and technical documentation into a request for quotation pack; registering information in one of the item bidding process for commodity parts or devices or the service bidding process for non-commodity parts or devices(Note abstract and see column 1-8 lines 1-67) selecting the suppliers that are to receive the request for quotation pack; making the request for quotation pack available to selected suppliers on a supplier on-line system web site; and e-mailing all suppliers that the request for quotation pack is available at the web site. (Note abstract and see column 1-8 lines 1-67).

As per claim 2, Giovannoli discloses further including: reviewing, by the supplier, the available request for quotation pack; responding, by the supplier, by generation of a quotation corresponding to the request for quotation pack, submitting the quotation to the recited supplier on-line web site; and e-mailing automatically by the supplier on-line system, the buyer that the supplier has entered a quotation. (Note abstract and see column 1-8 lines 1-67).

As per claim 3, Giovannoli discloses further including:

Art Unit: 3692

analyzing automatically the request for quotation pack to determine a last day available for the supplier to respond, determining, if the day the quotation is provided by the supplier is prior to the last day to respond to the request for quotation pack; and providing the buyer with the capability to review quotations for request for quotation pack received prior to the last day to respond. (Note abstract and see column 1-8 lines 1-67).

As per claim 4, Giovannoli discloses further including:
determining whether a need exists to alter the last day for responding to a request for quotation;
altering the last day suppliers may respond to a request for quotation;
and transmitting, automatically, e-mail notifications to the suppliers that the last day to respond to the request for quotation has been altered. (Note abstract and see column 1-8 lines 1-67).

As per claim 5, Giovannoli discloses wherein the action of making the request for quotation with the attached documents available to select suppliers includes synchronizing the data in the request for quotation with internal and external databases in order to transfer the files to a designated web site. (Note abstract and see column 1-8 lines 1-67).

As per claim 6, Giovannoli discloses further including a action of downloading documentation from sources outside of the supplier on-line system for inclusion into the request for quotation pack. (Note abstract and see column 1-8 lines 1-67).

As per claim 7, Giovannoli discloses further including an automatic document transfer process which generates files to be included in the request for quotation pack wherein the automatic document transfer process transfers the generated files to individual supplier folders maintained on a back end supplier on-line server. (Note abstract and see column 1-8 lines 1-67).

As per claim 8, Giovannoli discloses further including an upload document transfer process wherein a supplier is able to upload document information to the supplier on-line system which may be received by the buyer. (Note abstract and see column 1-8 lines 1-67).

As per claim 9, Giovannoli discloses further including:
registering part or device number information within the bidding process for the commodity parts or devices; and
selecting the documentation that is to be attached to individual parts or devices of the request for quotation to form the request for quotation pack. (Note abstract and see column 1-8 lines 1-67).

Conclusion

RESPONSE TO ARGUMENTS

6. In response to Applicant's arguments filed 3/21/2007 has been fully considered but they not persuasive for the following reasons.

7. In response to Applicant's arguments that Giovannoli fail to teach or suggest using e-mail attachments or the features of claim 1" the Examiner disagrees with Applicant's because these limitations were addressed as stated .

Giovannoli discloses a method of exchanging data between a buyer and a plurality of multiple suppliers via an internet supplier on-line system:

generating by a buyer a request for a quotation from at least some of the plurality of suppliers for a cost of a part or device(Note abstract and see column 1-8 lines 1-67)

determining if the request for the quotation will include attachments; generating documents when the request for quotation will include attachments, wherein the

request for quotation and attachments include both engineering and business documents determining which of the plurality of suppliers are to be provided with the request for quotation and attachments(Note abstract and see column 1-8 lines 1-67)

inquiring whether all suppliers to be provided with the request for quotation and attachments are registered on the supplier on line system;

registering the suppliers not on the supplier on-line system;

notifying the buyer, automatically by the supplier on-line system, of the registration of the suppliers(Note abstract and see column 1-8 lines 1-67)

determining whether the request for quotation is for a commodity part or device or is for a non-commodity part or device and selecting which of the generated documents are to be attached as part of an item bidding process corresponding to each of the

Art Unit: 3692

commodity parts or devices or selecting which of the generated documents are to be attached as part of a service bidding process corresponding to each of the non commodity parts or devices, building the request for quotation, wherein the building includes joining the business and technical documentation into a request for quotation pack; registering information in one of the item bidding process for commodity parts or devices or the service bidding process for non-commodity parts or devices(Note abstract and see column 1-8 lines 1-67) selecting the suppliers that are to receive the request for quotation pack; making the request for quotation pack available to selected suppliers on a supplier on-line system web site and e-mailing all suppliers that the request for quotation pack is available at the web site. (Note abstract and see column 1-8 lines 1-67).

It is inherently clear the Applicant's claimed limitations were addressed with the teachings of Giovannoli.

8. Applicant's claim 1, states " wherein the request for quotation and attachments include both engineering and business documents"

However the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

**>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the

Art Unit: 3692

claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In *re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous.

Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 3692

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

June 6, 2007


FRANTZY POINVIL
PRIMARY EXAMINER
Au 3692